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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/802,797	03/09/2001	Jon Marcus Randall Whitten	MS1-768US	8294

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EXAMINER

JONES, SCOTT E

ART UNIT	PAPER NUMBER
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3713

DATE MAILED: 02/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/802,797

Applicant(s)

RANDALL WHITTEN ET AL.

Examiner

Scott E. Jones

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 December 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-71 is/are pending in the application.
- 4a) Of the above claim(s) 53-56 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-52 and 57-71 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Response to Amendment

1. This office action is in response to the amendment filed on December 9, 2002 in which applicant amends claims 1-31, 33-34, 36-40, 43, 45-46, 48-51, and 53-60, adds new claims 61-71, and responds to the claim rejections.

Double Patenting

2. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Applicant is advised that should claim 58 be found allowable, claim 59 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-9, 12-19, 21-22, 24-25, 27, 34-35, 43, 48, 50-52, 57-58, 60, and 61-71 are rejected under 35 U.S.C. 102(e) as being anticipated by Tanaka (U.S. 6,299,535).

The rejection as stated in Office Action, Paper No. 5 is retained and incorporated herein.

5. Claims 1, 10-11, 13, 18, 20, 22-23, 26-33, 36-43, 44-49, and 57 are rejected under 35 U.S.C. 102(b) as being anticipated by Links 386CD Players Manual.

The rejection as stated in Office Action, Paper No. 5 is retained and incorporated herein.

Response to Arguments

6. Applicant's arguments filed December 9, 2002 have been fully considered but they are not persuasive.

Applicant traverses the rejection to claims 1-9, 12-19, 21-22, 24-25, 27, 34-35, 43, 48, 50-52, 57-58, and 60 under 35 U.S.C. 102(e) as being anticipated by Tanaka (U.S. 6,299,535). Applicant alleges Tanaka, while making various references to playing video games with a game system, teaches of a personal computer that functions as a general computer. Furthermore, applicant alleges, unlike Tanaka that teaches of a boot operating system that is stored in ROM 13, the instant invention boots from instructions on Hard Disk Drive 15. However, in response

to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., Boot into a video game system console from boot instructions on hard disk drive 15) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Furthermore, claims 12, 14, and 43 state, "the game console boots into a console application stored on the hard disk drive." Most all computer systems, including Tanaka's game system, boot into an application stored on the hard disk drive, or any other type of disk drive or other portable memory device for that matter.

Claim 13 states, "a hard disk drive coupled to the processor, the hard disk drive being configured to boot the game console..." Again, most all computer systems, including Tanaka's game system, are configured to boot into a console application stored on the hard disk drive, or any other type of disk drive or other portable memory device for that matter.

Claim 43 states, "booting a game console from a non-removable hard disk drive integrated into the game console..." However, the claim does not explicitly state that the boot program is stored on the hard disk drive, and therefore does not preclude that the hard disk drive is configured to retrieve these instructions from the boot program stored on ROM, disk drive or other portable memory device for that matter.

Additionally, applicant alleges Tanaka is not described specifically with respect to a video game console for playing video games, and more particularly is not taught as initially loading a video game program in the boot sequence. First, Tanaka's video game system, or

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personal computer, etc. is equivalent to applicant's game console. Second, Tanaka's device can run many other applications in addition to executing instructions to play a video game. Third, to one having ordinary skill in the art at the time of applicant's invention, it was notoriously well known that computers can be booted directly from various electronic storage media, such as, from the ROM, CD-ROM, floppy disk, hard disk drive, or other portable memory device for that matter. For instance, upon powering up computers, these systems are configured to scan other internal disk drives. The normal boot program is overridden upon detecting a disk having boot instructions in one of the other drives upon powering up. One reason this sequence is followed is because a computer may crash and not be able to re-boot unless a user installs an "emergency boot disk" in one of the drives.

7. Applicant traverses the rejection to claims 1, 10-11, 13, 20, 22-23, 26-33, 36-43, 44-49, and 57 under 35 U.S.C. 102(b) as being anticipated by Links 386CD Players Manual. However, applicant relies on arguments similar to those provided for the Tanaka reference. Please see the explanation provided above.

8. For the reasons discussed hereinabove, the rejections as stated in Office Action, Paper No. 5 under 35 U.S.C 102(e) and (b) are maintained.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott E. Jones whose telephone number is (703) 308-7133. The examiner can normally be reached on Monday - Friday, 8:30 A.M. - 5:30 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Valencia Martin-Wallace can be reached on (703) 308-4119. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

SEJ

sej
February 11, 2003

D. Martin-Wallace
VALENCIA MARTIN-WALLACE
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